

### REMARKS

Reexamination and reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks. Applicant notes the Examiner's consideration of the information cited in the Information Disclosure Statement filed March 31, 2004, as acknowledged in the Office Action Summary.

Claims 1-34 are pending in this application. Claims 12-14, 23-34 have been withdrawn from consideration due to a restriction requirement. No new claims have been added. The limitations of claims 2, 7 and 17 have been incorporated into claims 1, 6 and 15, respectively. Claims 1 and 6 have been further amended to overcome the rejection under 35 U.S.C. § 112 set forth *infra*. In addition, claims 1, 6 and 15 have been further amended to change "diastereomers, enantiomers" to --diastereomers or enantiomers--.

#### Rejection Under 35 U.S.C. § 112

Claims 1, 6 and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner has suggested that "and ... salts" be changed to --or ... salts--. The suggestion has been adopted and claims 1, 6 and 15 have been amended accordingly. By these amendments, the rejection should be overcome.

#### Rejections Under 35 U.S.C. § 102

Claims 1-3 and 6-9 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Flammia et al. reference. According to the Examiner, the claims are anticipated by formulas 18 and 19 at page 3729 of the reference. The reference appears to have an effective publication date of August 17, 1999, the date it was published on the web. Applicant's earliest application was filed on July 30, 1999 and discloses compounds 18 and 19 relied upon by the Examiner. Claims

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1-3 and 6-9 are the invention of Peter Crooks and Linda Dwoskin. Since the invention of applicant antedates the Flamma reference, it is requested that the rejection be reconsidered and withdrawn.

Claims 15-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Crooks et al. (U.S. Patent No. 5,830,904). According to the Examiner, the claims are anticipated by formula (I) in col. 5 of the patent, which discloses a Lobeline compound having saturated bonds between the pyridine ring and the benzene rings. Claims 15-22 are the invention of Peter Crooks and Linda Dwoskin. The reference has an effective date of February 5, 1997 and is not a statutory bar under 35 U.S.C. § 102(b). Declarations from Peter Crooks and Linda Dwoskin under 37 C.F.R. § 1.131 is attached. Accordingly, it is requested that the rejection be reconsidered and withdrawn.

#### **Obviousness-Type Double Patenting Rejections**

Claims 1-11 and 15-22 stand rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,455,543. Claims 1-11 and 15-22 stand rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,943,177. Should allowable subject matter be found, Applicant intends to file a terminal disclaimer.

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### Conclusion

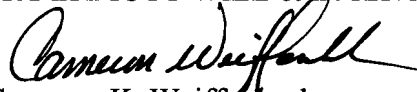
For the foregoing reasons, it is submitted that the claims 1-11 and 15-22 are patentable over the teachings of the prior art relied upon by the Examiner. Accordingly, favorable reconsideration of the claims is requested in light of the preceding amendments and remarks. Allowance of the claims is courteously solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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